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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,452	05/04/2001	Michael Lassner	02-104910US	8657

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EXAMINER

DAVIS, KATHARINE F

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 07/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,452

Applicant(s)

LASSNER ET AL.

Examiner

Katharine F. Davis

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-127 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-127 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-40 and 74-77, drawn to a method for identifying a plant disease resistance gene with a specified characteristic, classified in Class 435, subclass 6.
- II. Claim 41, drawn to a transgenic plant that expresses a product of an R gene with a specified characteristic, classified in Class 800, subclass 295.
- III. Claims 42-44, drawn to a method of conferring resistance to at least one plant pathogen by introducing an R gene with a specified characteristic into a plant or plant cell, classified in Class 435, subclass 468.
- IV. Claims 45-70, drawn to a method for identifying an elicitor of a plant defense response with a desired property, classified in Class 435, subclass 6.
- V. Claims 71 and 72, drawn to a method of inducing a plant defense response by exposing at least one plant cell to an elicitor with a desired property, classified in Class 435, subclasses 6 and 468.
- VI. Claims 73 and 78-82, drawn to a method for identifying a functional interaction between a plant resistance gene and an elicitor; the method comprising introducing a first viral vector comprising a plant disease resistance gene and a second viral vector comprising a gene encoding an elicitor or an enzyme catalyzing production of an elicitor into at least one plant cell such that the R gene

Art Unit: 1636

and the elicitor are cytoplasmically expressed in the plant cell and detecting a plant defense response, classified in Class 435, subclasses 6 and 468.

- VII. Claims 83-93 drawn to a method for identifying a functional interaction between a plant resistance gene and an elicitor; the method comprising exposing at least one plant cell to a plant pathogen comprising an elicitor of a plant defense response and a plant resistance gene and detecting a plant defense response, classified in Class 435, subclass 4.
- VIII. Claims 94-104, drawn to a bio-detector comprising an R gene encoding a product capable of activation by at least one elicitor and a reporter operably linked to a promoter responsive to the activated product of the R gene; additionally the claims are drawn to a plant and/or plant cell comprising the bio-detector of claim 94, classified in Class 435, subclasses 6 and 320.1; Class 800, subclass 295 and Class 435, subclass 410.
- IX. Claims 105-127, drawn to a method for producing a gene with a desired property, classified in Class 435, subclasses 6 and 320.1 and Class 536, subclass 23.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the transgenic plant of Invention II can be made by other methods; for example transfection of a

Art Unit: 1636

plant cell with a well-known R gene followed by generation of the transfected plant cell into a plant (wherein the R gene is not required to be identified by the methods of Invention I).

Inventions I and III-IX are all unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case each of the methods of Inventions I, III-VII and IX has distinct procedural steps to provide distinct functions resulting in separate outcomes and each of the methods can be practiced in separate applications. Invention VIII is unrelated to all of the other invention groups as Invention VIII encompasses a specific product (a bio-detector and plants and plant cells comprising said bio-detector) not made by any of the claimed methods of the other invention groups.

Furthermore, Inventions I-IX are separate and distinct as they require materially different searches; the terms used for a prior art search of one method, transgenic plant/plant cell and/or bio-detector will not necessarily be terms which encompass all of the methods, transgenic plant/plant cell and/or bio-detectors. Each method would require additional search terms resulting in additional material to be reviewed as possible art, thus concluding that a search of all of the claimed inventions together would constitute a burdensome search. Because these inventions are distinct for all of the reasons discussed above and have acquired a separate status in the art because of their recognized divergent subject matter and separate search requirements, restriction for examination purposes as indicated is proper.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1636

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katharine F. Davis whose telephone number is (703) 605-1195 with direct desktop RightFax (703) 746-5199. The examiner can normally be reached on Monday-Friday (8:30am-5:00pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-1935 for After Final communications. Any inquiry of a general nature or any inquiry concerning the formalities of this application should be directed to Patent Analyst Tracey Johnson whose telephone number is (703) 305-2982.

Katharine F. Davis
July 1, 2002


REMY YUCEL, PH.D
SUPERVISORY PATENT EXAMINER
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